

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the pending claims and the following remarks.

Amendments to the Claims

Upon entry of the present amendment, claims 3 and 5-6 will be pending in the present application. Claims 1-2 and 4 have been cancelled herein. Claims 3 and 5 have been amended. Claim 6 has been added.

No new matter has been added by way of these amendments because each amendment is supported by the present specification or editorial in nature. For example, the amendment to claim 3 finds support in claims 1-2 and 4 as originally filed.

Support for new claim 6 can be found in the specification, *inter alia*, at page 5, lines 12-14.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 102(b)

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Okada et al. '044 (US 2002/0035044) (see paragraphs 1-3 at page 2 of the Office Action). Claim 1 has been cancelled herein, which renders the rejection moot.

Issues under 35 U.S.C. § 103(a)

Claims 2-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Okada et al. '044 in view of Cody et al. '692 (US 6,322,692) (see paragraphs 4-11 at pages 3-5 of the Office Action). Claims 2 and 4 have been cancelled herein, which renders the rejection as to these claims moot. With respect to the remaining claims, Applicants respectfully traverse, and reconsideration and withdrawal of the rejection is respectfully requested.

Applicants have noted paragraphs 8-11 (pages 3-5) of the outstanding Office Action.

In the field of engine oils used for automobiles and industries, gear oils (including ATF), hydraulic fluids, and the like, the utilization of highly purified lubricating oil bases, such as oils classified in groups (II) and (III), has increased in place of oils classified in group (I), which have been previously conventionally widely used as a lubricating oil base. This increase in these use of group (II) and group (III) oils has been the result of the sophistication of required properties associated with new standards and the enforcement of environmental regulations. Engine oil applications especially have a significant problem in that the low-temperature viscosity, as measured by Mini-Rotary Viscometer (parameters of oil pumping properties), which is a major standard, has increased.

Based on this premise, the present invention solves the intrinsic problems of the **highly purified lubricating oil bases, such as oils classified in groups (II) and (III)**, by adding particular ethylene propylene copolymers and particular pour-point depressants to highly purified lubricating oil bases.

Applicants respectfully submit that the presently claimed invention is unobvious over Okada et al. '044 in view of Cody et al. '692.

Comparing Examples 1-3 with Comparative Examples 1-2 of the specification, the lubricating oil composition containing the ethylene propylene copolymer having the intrinsic viscosity $[\eta]$ defined by the present invention has an unexpectedly low MRV.

Comparing Examples 4 and 7 with Examples 10 and 13 (which are now effectively comparative examples in view of the present amendment), the lubricating oil composition of the present invention containing a pour-point depressant (C) and having a melting point as measured with DSC of not higher than -13°C , has an unexpectedly low MRV. The above results are also shown when comparing Examples 5 and 8 with Examples 11 and 14 (also now comparative examples in view of the amendments to the claims) and Examples 6 and 9 with Examples 12 and 15 (now comparative examples).

Relevant to this § 103(a) rejection, *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) has provided the controlling framework for an obviousness analysis, wherein a proper analysis under § 103(a) requires consideration of the four *Graham* factors. One such

factor includes the evaluation of any evidence of secondary considerations (e.g., commercial success; unexpected results). 383 U.S. at 17, 148 USPQ at 467. In this regard, Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness. See *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). Also, the comparative showing need not compare the claimed invention with all of the cited prior art, but only with the closest prior art. See MPEP 716.02(b) and 716.02(e).

In this regard, Applicants note MPEP 2144.08(5)(B), which states that rebuttal evidence and arguments can be presented in the specification, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Thus, due to the unexpected results as achieved by the present invention, this rejection has been overcome.

Moreover, the pour-point depressant “ACLUBE 133” (melting point -11.4°C) used in Example 10 of the present specification (now a comparative example) is the pour-point depressant used in Okada et al. ‘044. As such, Okada et al. ‘044 do not meet each and every limitation of claim 3, from which claims 5 and 6 depend. Specifically, claim 3 recites, *inter alia*, “**a pour-point depressant (C) having a melting point as measured with DSC of not higher than -13°C**” (emphasis added). None of the cited prior art teach this limitation.

Cody et al. ‘692 only disclose a viscosity index, a sulfur content, and saturates content. As such, the combination of Okada et al. ‘044 and Cody et al. ‘692 fail to teach or suggest each and every limitation of independent claim 3.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above, the combination of references fails to teach or suggest all the claim limitations of pending independent claim 3 (and those dependent thereon). Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

For the reasons given above, reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION


A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

By 

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